



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,547	06/05/2001	Dan Kikinis	ISURFTV139	6896
52940	7590	11/14/2005	EXAMINER	
TODD S. PARKHURST HOLLAND & KNIGHT LLP 131 S. DEARBORN STREET 30TH FLOOR CHICAGO, IL 60603			LAYE, JADE O	
			ART UNIT	PAPER NUMBER
			2617	
DATE MAILED: 11/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,547

Applicant(s)

KIKINIS, DAN

Examiner

Jade O. Laye

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

I. Applicant's amended Claims, Drawings, and Specification, dated 10/11/05, have been entered and made of record. Accordingly, the Objections applied in the previous action are hereby withdrawn.

Response to Arguments

II. Applicant's arguments filed 10/11/05 have been fully considered but they are not persuasive. Accordingly, **THIS ACTION IS MADE FINAL**.

Applicant argues that Hassell et al fail to disclose a method by which the user is allowed to transfer stored programs to a removable storage device "without requiring the use of menus or options." (Applicant's Response, Pg. 10). As discussed in the previous Non-Final Action, Hassell does in fact disclose a method by which a user is allowed to transfer a stored program to a removable medium via the use (i.e., single actuation) of a "transfer" button located on a user interface. (Par. [0081]). However, Applicant argues his invention does so "without requiring the use of menus or options." Without addressing the accuracy of this argument, the Examiner would like to point out that Applicant's claim language does not reflect this feature. The Claims as written do not exclude the use of menus or options. Accordingly, the Examiner is not required to address this limitation.

Moreover, Applicant's amended claim language is not sufficient to overcome the art of record. As to Claims 1, 8, and 15, Hassell's system (which is an "entertainment system") does

allow a user to transfer programs to other storage devices after pushing a “transfer” button on the remote control. The initialization of the “transfer” button can be broadly read to denote a “single selection” because once the user presses the “transfer” button, it alone will initiate the program transfer. Accordingly, each and every limitation of Claims 1, 8, and 15 remain anticipated by Hassell et al.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

III. Claims 1, 3- 8, 10-15, and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hassell et al. (US Pat. Pub. No. 2004/0128685).

As to claim 1, Hassell discloses a entertainment system comprising a set top box (STB) capable of displaying an electronic programming guide (EPG). In response to the user pushing a “transfer” button on the remote, a program and related data can be transferred from a first storage device located in the STB to another removable storage device located within the STB or separate from the STB. (Pars. [0006, 0008, 0019, 0020, 0021, & 0081]). Therefore, Hassell et al anticipate each and every limitation of claim 1.

Claims 8 and 15 correspond to the method claim 1. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 3, Hassell further teaches the use of a remote, wherein the transfer is initiated by the user pressing the “transfer” button. (Par. [0081]). Therefore, Hassell et al anticipate each and every element of claim 3.

Claims 10 and 17 correspond to the method claim 3. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 4, Hassell further teaches that in response to the single selection of the transfer button, the system transfers programs and related data from the removable storage medium to another storage device (i.e., volume) within the STB. (Pars. [0037, 0039, 0040, 0081]). Therefore, Hassell et al anticipate each and every limitation of claim 4.

Claims 11, and 18 correspond to the method claim 4. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 5, Hassell further teaches the system maintains a media library contained within the storage device, which can track/update the directory according to the viewers preferences. (Par. [0085 & 0086]). Therefore, Hassell et al anticipate each and every limitation of claim 5.

Claims 12 and 19 correspond to the method claim 5. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 6, Hassell further discloses that upon selecting a program that has been transferred to the removable storage device, the STB will prompt the user to insert the removable storage device if its not presently inserted in the STB. (Pars. [0089 & 0109]). Therefore, Hassell et al anticipate each and every limitation of claim 6.

Claims 13 and 20 correspond to the method claim 6. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 7, Hassell further teaches the removable storage device can be a DVD-RAM. (Par. [0008]). Therefore, Hassell et al anticipate each and every limitation of claim 7.

Claims 14 and 21 correspond to the method claim 7. Accordingly, each is analyzed and rejected as previously discussed.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

IV. Claims 2, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al.

Applicant's claim 2 recites the method of claim 1, wherein the single selection includes a single pressing of a selected portion on a control panel of the STB. As discussed above, Hassell et al disclose all limitations of claim 1, and further teach the user input interface can be a wireless remote, keyboard, etc. or any other suitable input device. (Par. [0025]). Although not specifically disclosed, this teaching does encompass the limitation of claim 2. Therefore, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to modify this teaching of Hassell in order to provide a system whereby the user interface was the STB itself, thus providing an alternative method of user interaction.

Claims 9 and 16 correspond to the method claim 2. Accordingly, each is analyzed and rejected as previously discussed.

Conclusion

V. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 2617

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye

October 31, 2005.

A handwritten signature in black ink, appearing to read 'Vivek Srivastava', with a long horizontal flourish extending to the right.

VIVEK SRIVASTAVA
PRIMARY EXAMINER